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Bonnie L. Germe

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Gerald W. Ingram et al. : Paper No.:
Serial No.: 09/847,999 : Group Art Unit: 2177
Filed: May 4, 2001 : Examiner: Pham, Khanh B.
For: Method for Adding a Plurality of User Selectable Functions to a Hyperlink

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
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Technology Center 2100

Dear Sir:

Submitted herewith in **triplicate** is an Appeal Brief in response to the Notification of Non-Compliance dated February 06, 2004. The government fee in the amount of \$320.00 for filing the present Appeal Brief was charged to our Visa credit card account with the original Appeal Brief filed by Certificate of Mailing on December 8, 2003.

Please charge any additional fees required in connection with the present communication, or credit any overpayment, to Deposit Account No. 04-1133.

Respectfully submitted,

By

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Bonnie S. Gernue

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Gerald W. Ingram et al. : Paper No.:
Serial No.: 09/847,999 : Group Art Unit: 2177
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For: **Method for Adding a Plurality of User Selectable Functions to a Hyperlink**

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
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P.O. Box 1450
Alexandria, VA 22313-1450

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FEB 23 2004

Technology Center 2100

Dear Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed by Certificate of Mail on December 2, 2003 and received by the U.S. Patent and Trademark Office on December 8, 2003, and in response to the Notification of Non-Compliance dated February 06, 2004.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is the assignee of the present application, Ilor Inc.

II. RELATED APPEALS AND INTERFERENCES

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There are no other appeals or interferences known to the Appellants, the Appellants' undersigned legal representative or the assignee which will directly effect or be directly effected by or having a bearing on the Board's decision in the present appeal.

III. STATUS OF THE CLAIMS

Claims 1-30 have been cancelled and claims 31-33 are pending in this application and stand rejected. Claims 31-33 are the subject of the present appeal. A complete copy of rejected claims 31-33 is set forth in the Appendix A.

IV. STATUS OF AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION

An Amendment Under 37 C.F.R. 1.116 was submitted by Certificate of Mailing on December 2, 2003. The Advisory Action dated December 23, 2003 indicated that the Amendment will be entered upon the filing of an appeal. In the Amendment, claims 26-30 were cancelled in order to reduce the issues on appeal. The Appendix submitted herewith does incorporate the amendments set forth in the Amendment under 37 C.F.R. 1.116.

V. SUMMARY OF THE INVENTION

The present invention is directed to a method of operating a computer for providing a plurality of user selectable functions to a hyperlink (see, for example, the specification at page 4, lines 2-18). More particularly, according to claim 31, the method of operating a computer comprises:

providing a visual display;

displaying digital content in a first window on the visual display, the digital content including a hyperlink;

providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink;

visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed; and

selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection;

wherein the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink (see, for example, the specification at page 4, lines 17-20 and page 8, lines 7-17).

Claims 32 and 33 further define the method of claim 31. According to claim 32, the designation of a hyperlink comprises positioning a pointer at or near the hyperlink (see, for example, the specification at page 7, lines 14-21). According to claim 33, the second window comprises a temporary, session-based window (see, for example, the specification at page 12, lines 12-21).

VI. ISSUES ON APPEAL

The two issues presented on appeal for review by the Board are as follows:

I. The rejection of claims 31-33 under 35 U.S.C. §103(a) as being unpatentable over Newfield et al., “Scratchpad: Mechanisms for Better Navigation in Directed Web

Searching”, 1998 (hereafter “Newfield”) in view of Gennaro (U.S. Patent No. 5,742,768) and further in view of Jain (US 2003/0030679); and

II. The provisional rejection of claims 31-33 under 35 U.S.C. §101 as claiming the same invention as that of claims 174, 175 and 176 of copending Application No. 09/594,786.

VII. GROUPING OF THE CLAIMS

With respect to the above-noted issues on appeal and for the purposes of this appeal only, Appellants concede that claims 32 and 33 stand or fall together with claim 31 from which they directly depend.

VIII. ARGUMENTS

A. The Rejection Under 35 U.S.C. §103

The claimed methods are nonobvious over and patentably distinguishable from Newfield in view of Gennaro and further in view of Jain and, accordingly, the rejection of claims 31-33 under 35 U.S.C. §103 should be reversed.

1. The Examiner’s Position

The Examiner conceded in the office action dated November 6, 2003 that neither Newfield or Gennaro teach the non-linking functionality of copying any associated graphical elements corresponding to the hyperlink to the second window, wherein the associated graphical element comprises a graphical image embedded in the hyperlink. The Examiner took the position that Jain teaches the step of copying any associated graphical element embedded in the hyperlink to the second window and, based upon that premise, asserted it would have been obvious to one of ordinary skill in the art to modify Newfield with Gennaro

and Jain in order to make it easier for the user to recognize the hyperlink by viewing its associated graphical image.

As reflected in the Interview Summary mailed November 19, 2003, the Examiner's rejection of claims 31-33 is premised upon his contention that the claim language "graphical image embedded in the hyperlink" is met by a reference (Jain) that includes graphical image in any target web page to which the hyperlink points.

2. Claims 31-33 are Nonobvious Over Newfield, Gennaro and Jain

As noted above, the method of operating a computer, as defined by claim 31, comprises, inter alia, the non-linking functionality of automatically copying a hyperlink to a second window in response to a selection includes copying a graphical image **embedded in the hyperlink** to a second window.

Newfield, on the other hand, discloses activating a program or option in a browser and then upon selection of a hyperlink copying the hyperlink to a list rather than opening the hyperlink. When the program (Scratchpad) is activated, the user only has one option when selecting a hyperlink. More specifically, the only available option is the copying of the hyperlink to a list for later viewing. However, as noted by the Examiner, Newfield does not disclose any visual generation of options presented to the user upon designation of a hyperlink. In addition, Newfield does not disclose a plurality of individually selectable user options presented to a user in response to designation of a hyperlink.

Moreover, the Gennaro et al. reference discloses a method for providing a web page having an embedded hyperlink menu to a web browser and for displaying the web page to a user of the web browser. When a user moves a pointer over a hyperlink, a drop down menu with additional related hyperlinks is displayed. The user may select the original hyperlink or one of the additional hyperlinks in the drop down menu. Despite displaying additional hyperlinks, the user either clicks on and follows a particular hyperlink or ignores the

hyperlink. The user selectable options displayed in the drop down menu as disclosed by the Gennaro et al. reference consist only of linking functionality options (i.e. open the webpage corresponding to the hyperlink. In addition, as noted by the Examiner, Gennaro fails to teach any non-linking functionality, wherein the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a **graphical image embedded in the hyperlink**.

Jain, on the other hand, discloses a method and system for bookmarking a favorite page with a user-defined image. The method comprises the steps of displaying a website page along with its locator address; displaying a plurality of images on the page; allowing a user to manually select one of the images; and storing the image together with the locator address for the displayed page to bookmark the website page. While Jain allows a user to manually select any image displayed on a webpage to be associated with the URL for the displayed page in a bookmark list, Jain fails to teach or suggest copying any associated graphical elements corresponding to the designated hyperlink to the second window, and further wherein the associated graphical element comprises a **graphical image embedded in the hyperlink**. Moreover, Jain does not teach or suggest anything about copying a graphical image embedded in the hyperlink. In fact, the method of Jain looks at the entire webpage being displayed and allows a user to select any image to be copied to the bookmark listing for the displayed page (see paragraphs 0022 and 0023).

To establish prima facie obviousness of the claimed invention, all of the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Furthermore, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979).

Newfield, Gennaro or Jain, alone or in combination, do not disclose or suggest a method of using a computer comprising automatically copying a hyperlink including any associated graphical elements corresponding to the hyperlink to a second window, and further wherein the associated **graphical element comprises a graphical image embedded in the hyperlink**. The methods of the present invention allow a user to select a hyperlink and copy the hyperlink and any graphical image embedded in the hyperlink to a second window, wherein each hyperlink placed in the second window can be individually activated and processed. Since none of the references relied upon by the Examiner disclose or suggest that concept, there is no way the references could be combined to meet the limitations of Applicants claims.

Instead, as discussed in the personal interview between Applicant's Representatives and the Examiner on November 17, 2003, the Examiner has apparently relied on an improper interpretation of the claim limitation "graphical image embedded in the hyperlink." The Examiner asserted that the language "graphical image embedded in the hyperlink" can be interpreted to encompass any image associated with the hyperlink, "including the images embedded in the web page where the hyperlink points to". (Examiner's Interview Summary of Nov. 17, 2003 - Paper No. 11). More simply, the Examiner asserted the language "embedded in the hyperlink" also means embedded in the **target webpage** of the hyperlink. Clearly this is not even remotely similar to "embedded in the hyperlink". The present rejection is based upon the Examiner's assertion that the phrase "embedded in the hyperlink" also includes any images embedded in the target webpage to which the hyperlink points. However, the present invention does not comprise copying any images embedded in the target webpage. Instead, the present invention comprises copying any image embedded in the selected hyperlink of the current webpage.

The following example may help to clarify the Applicant's position on the disagreement of the claim scope of the present invention.

A webpage is typically coded in HTML (HyperText Markup Language). A portion of the HTML source code for one exemplary webpage is attached as Appendix B. As can be seen in Appendix B, the HTML source code contains multiple hyperlinks. One hyperlink is as follows:

```
<a href="/2003/11/19/politics/19DEAN.html?8hpib"><br><font  
size="-1">Remains of Dean Brother Found</font></a>
```

One skilled in the art will appreciate that the above is a hyperlink. The hyperlink begins with the hyperlink opening tag "<a href='webpage target of hyperlink'", then any text or images to be displayed with the hyperlink are embedded. Images are embedded by using the HTML tag "". After all text and images have been embedded in the hyperlink, the hyperlink is closed using the hyperlink closing tag "". For the above example, the webpage target of the hyperlink is "/2003/11/19/politics/19DEAN.html?8hpib" and the image file "20031119deanpromo.jpg" is displayed along with the text "Remains of Dean Brother Found".

Under the present invention, the user upon designation of the hyperlink is presented with a plurality of options, with one option including the non-linking functionality of automatically copying the hyperlink and any associated graphical element corresponding to the hyperlink to a second list, wherein the associated graphical element comprises a graphical image embedded in the hyperlink. The user selects the option of automatically copying the hyperlink and any associated graphical image embedded in the hyperlink to a second list. For the above example, the hyperlink of

and the image "20031119deanpromo.jpg" embedded in the hyperlink are copied to a second list.

Applicants believe that anyone skilled in the art would appreciate and understand the difference between a graphic element that is "embedded in the hyperlink" and one that is "embedded in the target webpage to which the hyperlink points". Quite simply, the phrase "embedded in the hyperlink" is limited to any graphical image actually embedded in the hyperlink and does not include any image in the target webpage to which the hyperlink points. It is therefore submitted that the presently claimed methods are non-obvious over and patentably distinguishable from Newfield in view of Gennaro et al. and in further view of Jain. Accordingly, the rejection of claims 31-33 under 35 U.S.C. §103 should be reversed.

B. The Provisional Rejection Under 35 U.S.C. §101

Appellants do not contest the Examiner's provisional rejection. "Once the provisional rejection has been made, there is nothing the examiner and the applicant must do until the other application issues." *In re Mott*, 539 F.2d 1291, 190 U.S.P.Q. 536, 541 (CCPA 1976). Upon favorable action on this appeal, this provisional rejection will be attended to.

IV. CONCLUSIONS

The method of operating a computer defined by claims 31-33 are therefore nonobvious over and patentably distinguishable from Newfield in view of Gennaro et al. and in further view of Jain. Accordingly, the rejection under 35 U.S.C. §103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. Oberhaus', written over a horizontal line.

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APPENDIX A

31. A method of operating a computer, comprising:
providing a visual display;
displaying digital content in a first window on the visual display, the digital content including a hyperlink;
 ² providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink;
 visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed; and
 selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection;
 wherein the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink.
32. The method of claim 31, wherein the designation of a hyperlink comprises positioning a pointer at or near the hyperlink.
33. The method of claim 31, wherein the second window comprises a temporary, session-based window.

APPENDIX B

Example portion of HTML webpage source code:

```
<html>

<IMG src="http://graphics7.nytimes.com/images/dropcap/w.gif"
width="46" height="33" align="left" border="0" alt="W">ASHINGTON,
Nov. 19; While the vast power blackout of Aug. 14 had many causes,
it was born in Northern Ohio on an otherwise ordinary afternoon,
according to a government investigation made public today.</p>
<P>An interim report by a United States-Canadian task force
concluded, as had been widely expected, that what could have been
relatively minor failures had cascaded into something much
greater.</p>
<A href="/2003/11/19/politics/19DEAN.html?8hpib"><IMG
Src="http://graphics7.nytimes.com/images/promos/homepage/20031119dea
npromo.jpg" WIDTH="100" HEIGHT="77" BORDER="0" vspace="5"><br><font
size="-1">Remains of Dean Brother Found</FONT></a>
<A href="/2003/11/19/international/asia/19LETT.html?8hpib"><IMG
src="http://graphics7.nytimes.com/images/promos/homepage/20031119jap
anpromo.jpg" WIDTH="100" HEIGHT="77" BORDER="0" vspace="5"><br><font
size="-1">Japan Heads<BR>to Iraq</FONT></a>
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